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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,799	01/15/2004	Herbert Peiffer	03/003 MFE	5434

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EXAMINER

CHEN, VIVIAN

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 06/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/757,799

Applicant(s)

PEIFFER ET AL.

Examiner

Vivian Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/05;5/04;1/04</u> . | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 8, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Claims 1-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over:

(a) claims 1-9 of U.S. Patent No. 6,855,395 (JANSSENS ET AL),
in view of KINOSHITA ET AL (US 5,824,394); and
in view of PEIFFER ET AL (US 2002/0160168) or PEIFFER ET AL (US
2002/0160171).

The above patent claims a transparent biaxially oriented polyester film suitable for packaging, wherein the film comprises a base polyester layer B and a polyester layer A on at least one surface of layer B, wherein layer A contains the recited size, amount, and size distribution of particles. However, the patent does not explicitly claim the recited acrylic coating.

KINOSHITA ET AL discloses that it is well known in the art to apply acrylic coatings to polyester films in order to improve adhesion and handling properties, wherein the acrylic coating comprises acrylate and/or methacrylate, and additional monomers such as amide-containing vinyl monomers (e.g., methacrylamide). (line 37-68, col. 3; column 5; line 1-24, col. 6; lines 1-4, col. 11; line 1-30, col. 12)

The PEIFFER ET AL references disclose that it is well known in the art to incorporate scrap film into polyester films in the recited amounts. (PEIFFER '168, paragraphs 0049-0053; 0078)(see corresponding portions of PEIFFER '171)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply an acrylic coating to the films claimed in the above patent in order to improve surface properties. One of ordinary skill in the art would have applied the coating

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after biaxial orientation in order to optimize control of coating thickness and surface properties, but before heat-setting (claim 6) in order to improve adhesion between the coating and the underlying polyester layers. It would have been obvious to adjust the relative proportions of acrylate and methacrylate monomers in the acrylic coating (claim 5) depending on the hardness and other physical/mechanical properties required for specific applications.

5. Claims 1-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over:

(a) claims 1-11 or copending Application No. 10/739,808 (US 2004/0142147);
in view of KINOSHITA ET AL (US 5,824,394); and
in view of PEIFFER ET AL (US 2002/0160168) or PEIFFER ET AL (US 2002/0160171).

The above copending Application claims a transparent biaxially oriented polyester film suitable for packaging, wherein the film comprises a base polyester layer B and a polyester layer A on at least one surface of layer B, wherein layer A contains the recited size, amount, and size distribution of particles. However, the copending Applications does not explicitly claim the recited acrylic coating.

KINOSHITA ET AL discloses that it is well known in the art to apply acrylic coatings to polyester films in order to improve adhesion and handling properties, wherein the acrylic coating comprises acrylate and/or methacrylate, and additional monomers such as amide-containing vinyl monomers (e.g., methacrylamide). (line 37-68, col. 3; column 5; line 1-24, col. 6; lines 1-4, col. 11; line 1-30, col. 12)

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The PEIFFER ET AL references disclose that it is well known in the art to incorporate scrap film into polyester films in the recited amounts. (PEIFFER '168, paragraphs 0049-0053; 0078)(see corresponding portions of PEIFFER '171)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply an acrylic coating to the films claimed in the above copending Application in order to improve surface properties. One of ordinary skill in the art would have applied the coating after biaxial orientation in order to optimize control of coating thickness and surface properties, but before heat-setting (claim 6) in order to improve adhesion between the coating and the underlying polyester layers. It would have been obvious to adjust the relative proportions of acrylate and methacrylate monomers in the acrylic coating (claim 5) depending on the hardness and other physical/mechanical properties required for specific applications.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 9 is rejected under 35 U.S.C. 102(b) as being anticipated by ULLMANN'S ENCYCLOPEDIA OF INDUSTRIAL CHEMISTRY (hereinafter ULLMANN'S) or ENCYCLOPEDIA OF POLYMER SCIENCE AND ENGINEERING (hereinafter POLYMER SCIENCE).

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ULLMANN'S and POLYMER SCIENCE both discloses food packaging films.
(ULLMANN'S, Table 3) (POLYMER SCIENCE (Table 8).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over KINOSHITA ET AL (US 5,824,394),

in view of PEIFFER ET AL (US 2002/0160168) or PEIFFER ET AL (US 2002/0160171).

KINOSHITA ET AL discloses a biaxially oriented polyester film suitable for packaging, wherein the film comprises a base polyester layer B and a polyester layer A on at least one surface of layer B, an acrylic coating layer, and optionally a metal layer, wherein layer A contains 10 or less wt% particles having an average particle size of 0.001-3 microns. The acrylic coating comprises acrylate and/or methacrylate, and additional monomers such as amide-containing vinyl monomers (e.g., methacrylamide). (line 37-68, col. 3; column 5; line 1-24, col. 6; lines 1-4, col. 11; line 1-30, col. 12) However, the reference does not explicitly disclose the recited use of recycled material or the recited SPAN98 values.

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The PEIFFER ET AL references disclose that it is well known in the art to incorporate particles with SPAN 98 values of less than 1.9 in order to retain high optical transparency and reduce film defects. The PEIFFER ET AL references also disclose that it is well known in the art to incorporate scrap film into polyester films in the recited amounts. (PEIFFER '168, paragraphs 0049-0053; 0078)(see corresponding portions of PEIFFER '171)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use particles with a highly uniform size distribution in order to maintain transparency and uniform surface properties. One of ordinary skill in the art would have applied the coating after biaxial orientation in order to optimize control of coating thickness and surface properties, but before heat-setting (claim 6) in order to improve adhesion between the coating and the underlying polyester layers. It would have been obvious to adjust the relative proportions of acrylate and methacrylate monomers in the acrylic coating (claim 5) depending on the hardness and other physical/mechanical properties required for specific applications.

10. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over:

(a) EUROPEAN PATENT APPLICATION 1 236 568 (EP '568); or

(b) JAPANESE PATENT APPLICATION 2002-307634 (JP '634); or

in view of KINOSHITA ET AL (US 5,824,394),

in view of PEIFFER ET AL (US 2002/0160168) or PEIFFER ET AL (US 2002/0160171).

EP '568 and JP '634 each disclose a transparent biaxially oriented polyester film suitable for packaging, wherein the film comprises a base polyester layer B and a polyester layer A on at

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least one surface of layer B, wherein layer A contains the recited size, amount, and size distribution of particles. However, the copending Applications does not explicitly claim the recited acrylic coating.

KINOSHITA ET AL discloses that it is well known in the art to apply acrylic coatings to polyester films in order to improve adhesion and handling properties, wherein the acrylic coating comprises acrylate and/or methacrylate, and additional monomers such as amide-containing vinyl monomers (e.g., methacrylamide). (line 37-68, col. 3; column 5; line 1-24, col. 6; lines 1-4, col. 11; line 1-30, col. 12)

The PEIFFER ET AL references disclose that it is well known in the art to incorporate scrap film into polyester films in the recited amounts. (PEIFFER '168, paragraphs 0049-0053; 0078)(see corresponding portions of PEIFFER '171)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply an acrylic coating to the films disclosed in EP '568 and JP '634 in order to improve surface properties. One of ordinary skill in the art would have applied the coating after biaxial orientation in order to optimize control of coating thickness and surface properties, but before heat-setting (claim 6) in order to improve adhesion between the coating and the underlying polyester layers. It would have been obvious to adjust the relative proportions of acrylate and methacrylate monomers in the acrylic coating (claim 5) depending on the hardness and other physical/mechanical properties required for specific applications.

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Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 13, 2005



Vivian Chen
Primary Examiner
Art Unit 1773